

**Utility Patent**  
**Ser. No. 09/758,097**

a plurality of slide advance spring, each said advance spring tracked between each respective gripping bracket along said guide rail, wherein each respective slide is articulated and urged forward toward a projector lamp;

projection lens means toward the front of a housing;

a housing access door pivotally affixed to said housing such as to open in a clam-shell type manner to provide access to a housing internal cavity.

**REMARKS**

Reconsideration of the application as amended is respectfully requested.

Claim 1 was rejected under 35 USC 102(b) as being anticipated by Laizans.

In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102(b), a primary tenet is that only the CLAIMED designs are to be compared. Many differences exist between the design claimed in Laizans, and the currently claimed design. To briefly summarize the distinguishing features and characteristics of each, Laizans et al. does disclose a hand-held transparency projection; however, it is limited to use with "a film cartridge containing an endless loop of the film" and NOT a conventional, framed type of photographic slide. In fact, the disclosure and claims of Laizans et al. is specific to such a continuous film loop, and includes specific functional structures to retain the film loop, advance the film loop on a frame by frame basis, and rotate the projected image 90° from the centerline of the film image itself in order to direct the image outward from the projector.

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The present invention includes a number of features that are unanticipated in the above mentioned references, namely, a linear tracked carousel and the ability to be easily loaded with conventional projection slide medium. This is aided by a linear tracking carousel mechanism that advances the slides one at a time. These are features undisclosed and unanticipated in the art, namely,

Accordingly, the rejection by the examiner under 35 U.S.C. 102(b) is inappropriate.

Further, claims 2-4 and 6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Laizans et al in view of Walter, and claim 5 was rejected rejected under 35 U.S.C. 103(a) as being unpatentable over Laizans et al in view of Walter, and further in view of LiDonnici et al.

Walter discloses a slide carousel for a conventional slide projector that indexes the carousel slot positions by interlacing the slides and reversing half-way through the sequents, so that wen the sequence is finished the first position of the magazine is again in viewing position.

LiDonnici et al discloses a lamp changer that allows a burnt-out bulb on a conventional slide projector that has three or more lamps which automatically replace a burned out lamp without the need for interrupting the use of the slide projector.

Reserving the right to object to the applicability of these references as being relavent prior art, assuming so and based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument application wishes to point out that it is well established at law that for a

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proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed: "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of making a portable projector a housing having a generally tubular, portable shape the overall size and shape of a conventional flashlight and a slide projection means mounted

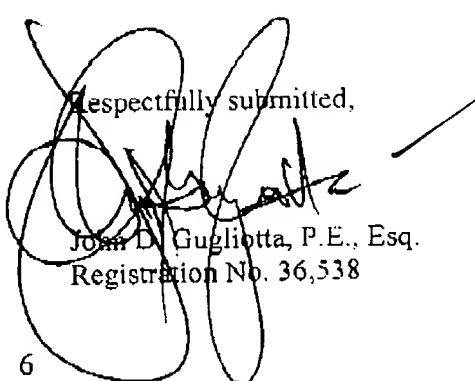
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within said housing for projecting a slide image from a lens mounted on an anterior end of said housing, wherein said slide image is loaded onto currently available, conventional projection slide medium. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,

  
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